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IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1943

No.

RICHARD W. WERNER,

Petitioner,

vs.

HEIN-WERNER MOTOR PARTS CORP.,
a Wisconsin Corporation,

Defendant-Appellee-Respondent.

PETITION OF RICHARD W. WERNER FOR A
WRIT OF CERTIORARI TO THE CIRCUIT
COURT OF APPEALS FOR THE
SEVENTH CIRCUIT
AND
SUPPORTING BRIEF

*To the Honorable, the Chief Justice of the United States
and Associate Justices of the Supreme Court of the
United States:*

Your Petitioner, Richard W. Werner, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit, to review the judgment of that court entered on the 30th day of April, 1943. A transcript of the record, including the proceedings in said Circuit Court of Appeals, is furnished herewith.

SUMMARY STATEMENT OF MATTER INVOLVED

1. This is a patent suit, in which the only issue is a matter of claim interpretation.

2. Claim 6 of Petitioner's patent No. 2,038,974 upon a hydraulic jack is the only claim in suit. Its validity, while placed in issue, has not been seriously challenged. The claim reads as follows:

6. A hydraulic jack comprising the combination with an upright cylinder and a concentric reservoir, of a base with which said cylinder and reservoir are in liquid tight relation, a ram operative in said cylinder, a duct in said base leading directly from the bottom of said cylinder to an exterior side surface of the base and provided at an intermediate point with a valve seat shoulder, a bleed valve threaded in said duct for axial adjustment therein to and from said shoulder, a pump chamber formed in said base and opening therefrom along an axis inclined with reference to said cylinder and intermediate said cylinder and said duct, a bypass duct leading from said first mentioned duct externally of said shoulder to said reservoir, a pump plunger operative in said chamber, a high pressure duct extending from the chamber to the first mentioned duct, and a supply duct in communication with the reservoir and leading to the high pressure duct, and check valves at the junction of the supply duct with the high pressure duct whereby to control liquid urged by the plunger from said reservoir to the cylinder.

3. Claim 6 is applicable verbatim to Respondent's accused jack. The District Court (E.D. Wis.) and Seventh Circuit Court of Appeals held claim 6 not to be infringed on the basis of an interpretation of the claim which involves the reading into the claim of a limita-

tion not expressed therein. The opinion below (Tr. 273) is published 57 Pat. Q. 268; 135 Fed. (2d) 187.

4. A major feature of the jack of the patent is the oblique angular position of the pump chamber, whereby it is intermediate the vertical ram cylinder and the almost horizontal release duct. (For a more complete description of the structure, see the appended brief.)

5. In the combination set forth in claim 6, the position of the pump intermediate the ram cylinder and the release duct, first, reduces leakage (by making possible a reduction in the number of plugs exposed to high pressure) and, secondly, permits the ram cylinder to be centered on the jack base (to avoid tipping) without reducing the possible ram extension. (In the prior art the ram cylinder either had to be nearer the end of the base or some of the ducts had to be located beneath the ram cylinder, thereby reducing the length and possible lift of the ram because the overall height of the collapsed jack is limited by the height of the vehicle axles beneath which it is used.)

6. Respondent's accused jack was designed before issue of Petitioners' patent with full knowledge of Petitioner's invention, which had been disclosed to Respondent by Petitioner in connection with the offer of a license. (Tr. 18)

7. Respondent's accused jack uses the intermediately located pump chamber of the patent in suit (1) to bring the ram cylinder toward the center of the base without increasing the height of the jack and (2) to reduce the number of external plugs subject to high pressure. The accused jack contains a single high pressure plug, whereas Respondent's previous jacks had from three to seven high pressure plugs.

8. Respondent's contention of non-infringement is based on a slight and colorable evasion. Its pump chamber, while disposed at an oblique angle between the ram cylinder and the relief duct, is slightly offset laterally from the plane in which the ram cylinder and release duct are located. Respondent points to the fact that the slight lateral offset of the pump chamber requires Respondent to use in the accused jack a cross bore closed by one high pressure plug, thus imperfectly realizing the advantages of the patent. However, the claim in suit does not mention plugs. Reduction in the number of plugs is not the invention, but is an *advantage* of the invention. Respondent has reduced the number of plugs and has thus achieved this advantage in substantial measure, though not to the fullest extent suggested by the patent.

9. Despite the fact that the pump chamber of Respondent's jack is geographically and functionally intermediate the ram cylinder and the release duct, in the sense in which the term "intermediate" is normally used, and despite the fact that Respondent's jack thereby achieves most of the objectives of the patent in suit, and despite the fact that claim 6 in suit does not require the pump chamber to be co-planar with the ram cylinder and the relief duct, the courts below nevertheless found the accused jack to escape infringement in the particular noted.

10. The art of record does not disclose any intermediate location of a pump chamber, or any structure comparable to that claimed, or any inclined pump chamber in the angle between the ram cylinder and the release duct in the same plane or otherwise. Consequently there is nothing in the art to require the claim in suit to be given the interpretation assigned to it by the Court below.

11. During pendency of the application for the patent in suit, claims referring to the location of the ducts in a single plane were considered. (Tr. 119) Absence of any such limitation from claim 6 in suit, therefore, indicates intent on the part of the Commissioner of Patents not to qualify the allowed claim in this respect.

12. The invention in controversy has been extensively recognized by the industry:

(a) One large manufacturer (American Grinder and Specialty Co.) holds a license under the patent in suit (Plaintiff's Exhibit 13).

(b) Two large jack manufacturers, strangers to this litigation, copied Plaintiff's construction when it first appeared on the market prior to the issue of the patent in suit, and, when charged with infringement, changed their constructions in recognition of the patent. (Tr. 25-27, 40).

(c) Respondent had shipped prior to the trial 443,729 of the accused jacks. (Ex. N and O).

QUESTIONS PRESENTED

The facts of the case present a single question which will first be phrased broadly and will then be phrased with specific reference to the facts of the present case:

In the complete absence of prior art requiring a narrow interpretation, is the Court justified in basing a finding of non-infringement upon a limitation not specifically recited in the claim but read into the claim by the Court?

Specifically, considering the importance of the invention and its significant impact on the industry, was the Court below justified in the present case in basing a find-

ing of non-infringement upon a limitation to a planar relationship not expressed in the claim, but which the Court arbitrarily supplied to support its findings, despite the fact that the claim is applicable verbatim to the accused structure and *the accused structure shows appropriation of the invention* with almost complete realization of the several objectives of the invention?

REASONS FOR GRANT OF WRIT OF CERTIORARI

The discretionary power of this Court is invoked upon the following grounds:

1. The decision rendered in this case by the Circuit Court of Appeals for the Seventh Circuit is in conflict with the decision of the Circuit Court of Appeals for the Sixth Circuit in *Cincinnati Cadillac Co. vs. English Mersick Co.*, 18 Fed. (2) 542 and with the decision of the Circuit Court of Appeals for the Second Circuit in *Samson-United Corporation vs. Sears Roebuck & Co., Inc.*, 103 F. (2) 312, (certiorari denied, 307 U.S. 638), and with the decision of the Circuit Court of Appeals for the Eighth Circuit in *Kansas City Southern Railway Co. vs. Silica Products Co.*, 48 F. (2) 503.

2. In this case, the Circuit Court of Appeals for the Seventh Circuit has decided an important question of federal law which has not been, but should be, settled by this court and as to which the decision of the Seventh Circuit Court of Appeals is probably in conflict with decisions of this Court in so far as the same are applicable.

Wherefore your Petitioner respectfully prays that a writ of certiorari issue out of, and under the seal of, this Court, directed to the United States Circuit Court of Appeals for the Seventh Judicial Circuit, commanding

said Court to certify and send to this Court, on a date to be designated, a full transcript of the record and full proceedings had in this case, to the end that this case may be reviewed and determined by this Court as to the questions presented hereby, and that the judgment of the Court of Appeals for the Seventh Circuit be reversed in so far as it found the Respondent not to have infringed claim 6 of the Petitioner's patent No. 2,038,974; and that Petitioner may be granted such other and further relief as may seem proper.

Respectfully submitted,

S. L. WHEELER,
Counsel for Petitioner.

Dated at Milwaukee, Wisconsin
July 28, 1943.